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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,740	08/28/2006	Ofer Glasberg	MET095.233411	5922

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WOLF, BLOCK, SHORR AND SOLIS-COHEN LLP  
250 PARK AVENUE  
10TH FLOOR  
NEW YORK, NY 10177

EXAMINER
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GEDEON, BRIAN T

ART UNIT	PAPER NUMBER
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3766

NOTIFICATION DATE	DELIVERY MODE
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03/06/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO@WOLFBLOCK.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,740	<b>Applicant(s)</b> GLASBERG ET AL.	
	<b>Examiner</b> Brian T. Gedeon	<b>Art Unit</b> 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 76-81 and 164-174 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 76, 77, 79, 80, 164-166, 168-170 and 172-174 is/are rejected.
- 7) ☒ Claim(s) 78, 81, 167, and 171 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/29/2007, 2/23/2007, 2/21/2007, 11/2/2006</u> .              | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

-or-

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 164, 168, and 172 are rejected under 35 U.S.C. 102(b) as being anticipated by Klepinski (US Patent no. 5,282,468).

In regard to claims 164 and 168, Klepinski describes a cuff electrode system 10, see figure 1, dimensioned and proportioned to fit around a nerve. Fingers 14a-14n and 16a-16n have a radius that is established to fit snugly around the outer circumference of a nerve, col 2 line 55 – col 3 line 6. Each finger contains an electrode contact.

In regard to claim 172, the fingers 14a-14n and 16a-16n are mounted on a support structure, 12, that is considered to be of an elongated rod shape.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 76, 79, 164, 166, 168, and 170 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bolea et al. (US Publication no. 2004/0010303).

In regard to claims 76, 79, 164, 166, 168, and 170, Bolea et al. disclose a method and device for applying an electrode cuff 302 to the exterior of a blood vessel, para [0086]. The electrode cuff 302 may extend around all or a portion of the circumference of the vessel. The electrodes are mounted on a substrate base layer 306, which may encapsulate and insulate the electrodes, para [0093]. The base substrate 306 may comprise electrically insulating material, and be of suitable length for wrapping around all (360°), or a portion of the circumference (disclosed to be less than 360°, or any of 270°, 180°, or 90°) of a blood vessel, para [0097]. The electrodes may be comprised of round wire, para [0098]. The electrodes are multipurpose, and can be used for electrical stimulation and for sensing, para [0099].

5. Claims 77, 80, 165, and 169 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolea et al. (US Publication no. 2004/0010303).

In regard to claims 77, 80, 165, and 169, Bolea et al. substantially describe the invention as claimed except for using the electrode cuff to provide stimulation to a hepatic nerve. However, in view that the electrode cuff of Bolea et al. is designed to sense or deliver electrical signals to a blood vessel, such as a carotid artery, wherein said cuff is disclosed to wrap around either the entire or portion of the circumference of

the vessel, therefore Examiner considers that it would not be beyond one of ordinary skill in the art at the time the invention was made to modify the electrode cuff of Bolea et al. to fit any blood vessel of interest since it would involve adjustments to the dimensions of the electrode cuff.

6. Claims 165, 169, 173 and 174 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klepinski (US Patent no. 5,282,468).

In regard to claims 165 and 169, Klepinski substantially describes the invention as claimed except for using the electrode system 10 to fit around a blood vessel. It is considered by the Examiner that since the electrode system of Klepinski is shaped and dimensioned to fit around an exterior circumference of an object similar in cross section to a blood vessel, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the electrode of Klepinski to stimulate blood vessels since doing so would not alter the function of the device, but just the intended location of placement.

In regard to claims 173 and 174, Klepinski substantially describes the invention as claimed except for the dimensions of the elongate rod shaped support structure. It would have been obvious to one with ordinary skill in the art at the time the invention was made to utilize 2-3 cm or 1-3 mm for the elongate rod shaped support structure since our reviewing courts have held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

*Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

### ***Allowable Subject Matter***

7. Claims 78, 81, 167, and 171 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to disclose alone or in combination the embodiment of the invention as claimed including the use of a removable curve needle to facilitate placement around a vein.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian T. Gedeon whose telephone number is (571) 272-3447. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on (571) 272-4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl H. Layno/  
Supervisory Patent Examiner, Art Unit 3766

Carl H. Layno  
Examiner  
Art Unit 3766

/B. T. G./  
Examiner, Art Unit 3766